

Application No.: 10/707,675

Docket No.: 60680-1814

REMARKS

Applicants have reviewed the Office Action mailed March 22, 2005, the Notice of Non-Compliant Amendment mailed December 7, 2005, and the Examiner's Communication mailed March 2, 2006. In response, Applicants respectfully request that the Supplemental Amendment filed on September 16, 2005 and the Response to the Notice of Non-Compliant Amendment timely filed on December 28, 2005 **not be entered**. Furthermore, Applicants desire to prosecute claims 1-10 as originally filed, and request that the Examiner reconsider the withdrawal made to claims 1-10 in the Non-Final Office Action dated March 22, 2005, for at least the reasons submitted below. Accordingly, Claims 1-11 remain pending in this application. Applicants request reconsideration of the pending claims in view of the following remarks.

Election/Restriction Requirement

The Examiner mailed a Restriction Requirement on February 14, 2005. In this Action, the Examiner required that Applicants elect between four Groups. Specifically, the following 'patentably distinct species' were identified by the Examiner:

Group I, Figure 1

Group II, Figure 2

Group III, Figure 3 and 5

Group IV, Figure 4

However, Applicants' specification clearly provides that "Figure 4 is an enlarged fragmentary cross-sectional view of a second member of the present invention shown in Figure 1." (Applicants' Specification, paragraph [0010]). Therefore, Group IV, as identified by the Examiner, is included in Group I, or alternatively, Group IV is improper. Importantly, Figure 4 is an enlarged view of a portion of Figure 1, illustrating detail of Figure 1. In the Election/Restriction requirement, the Examiner further required that the Applicants identify claims readable on the elected Group.

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Since no claims were directed to only the items illustrated in Figure 4, electing to prosecute claims directed only to Figure 4 would appear nonsensical.

Response to Election/Restriction Requirement

Applicants timely filed a response to a Election/Restriction Requirement on March 4, 2005. In this response, Applicants specifically elected Group I (not electing Figure 1 solely), and identified claims 1-11 as readable thereon.

By electing to prosecute the claims directed to Group I, Applicants were electing to prosecute claims directed to the embodiment of Figure 1, which has features illustrated in greater detail in Figure 4. After electing to prosecute claims directed toward Group I, Applicants proceeded to withdraw claims 12-19 and identify claims 1-11 as being the desired claims for prosecution.

Examiner's Action on Response to Election/Restriction Requirement

The Examiner issued a non-Final Office Action on March 22, 2005. In this response, the Examiner *sua sponte* withdrew claims 1-10 as not being drawn to the elected Group. Specifically, the Examiner stated that "claim 1 recites 'at least one groove for receiving a portion of said other member, said groove includes an opening and a base each having a predetermined width, said pre-determined (sic) width of said opening being generally less than said predetermined width of said base'; however, , the elected species, Group I, Figure 1, fails to meet this limitation." However, Figure 4 clearly illustrates an embodiment with "at least one groove for receiving a portion of said other member, said groove includes an opening and a base each having a predetermined width, said predetermined width of said opening being generally less than said predetermined width of said base." Since Figure 4 is an enlarged view of a portion of Figure 1, then Figure 1 supports this limitation of Claim 1 through the enlarged detail of Figure 4.

The Examiner proceeded to issue a 35 USC §102 rejection for claim 11.

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Applicants' Response to the Office Action

Applicants timely filed a response on June 21, 2005 to the Office Action mailed on March 22. In this response, Applicants amended claim 11 and made substantive arguments against the 35 USC §102 rejection for claim 11. (Applicants Response to Non-final Office Action filed on June 21, 2005, pages 8-9). Specifically, a deficiency of the prior art to anticipate the limitations of claim 11 was identified.

First Supplemental Response to the Office Action

Prior to receiving any further action by the Examiner, Applicants filed a Supplemental Amendment on September 16, 2005. In this Supplemental Amendment of September 16, 2005, new claims were added. Importantly, **claim 11 was not amended**, and Applicants **did not** submit substantive remarks regarding the 35 USC §102 rejection of March 22, 2005.

Notice of Non-Compliant Amendment

The Examiner mailed a notice of Non-Compliant Amendment on December 7 identifying the Supplemental Amendment of September 16, 2005 as Non-Compliant. Specifically, the Examiner stated that the "amendment filed on 9/16/2005 does not have a claim drawn to the elected invention and presenting only claims drawn to a non-elected invention is non-responsive."

Of most significance, the Examiner identified the communication mailed on December 7, 2005 as responsive only to the Supplemental Amendment filed on September 16, 2005, while not identifying any deficiency in the Response to Non-Final Office Action filed on June 21, 2005. Accordingly, the amendment to claim 11 made in the Response filed on June 21, 2005 was not identified as being drawn to a non-elected Group, nor were the remarks presented in the Response to Non-Final Office Action filed on June 21, 2005 identified as non-responsive.

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Response to Notice of Non-Compliant Amendment

Applicants timely filed a Response on December 28, 2005 to the Notice of Non-Compliant Amendment mailed on December 7, 2005. In the Response to the Notice of Non-Compliant Amendment filed on December 28, 2005, Applicants presented amendments to the specification and drawings. Significantly, Applicants presented no amendments to the claims, nor submitted substantive remarks regarding the 35 USC §102 rejection of March 22, 2005.

Examiner's Action of March 2, 2006

The Examiner mailed a Communication on March 2, 2006 (paper 20060227) stating, in part, that the reply filed on December 28, 2005 was not fully responsive because the "claims are directed to a non-elected invention." Again, the amendment to claim 11 made in the Response of June 21, 2005 was not identified as being drawn to a non-elected Group, nor were the remarks presented in the Response of June 21, 2005 identified as non-responsive.

Applicants' Response to the Office Action

Importantly, the Examiner has not responded to the Remarks made in the Response to Non-Final Office Action timely filed on June 21, 2005, nor has the Examiner alleged that the Response filed on June 21, 2005 was non-responsive. Since the Supplemental Amendment filed on September 16, 2005 and the Response to Non-Compliant Amendment filed on December 28, 2005 have not been entered, Applicants request that they not be entered and that this amendment be entered. If the Examiner makes a final determination that this Amendment is unresponsive, then the Examiner is kindly requested to issue an action in response to Applicants' Response to Non-Final Office Action filed on June 21, 2005.

Petition under 37 C.F.R. §1.144

Applicants filed a petition under 37 C.F.R. §1.144 on June 21, 2005. In the Petition, Applicants explained why the Election/Restriction Requirement, as a whole, was improper and requested that the Election/Restriction Requirement, as a whole, be withdrawn. Applicants requested that claims 1-19 (all claims) be examined.

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Decision on Petition

A Decision on the Petition under 37 C.F.R. §1.144 filed on June 21, 2005 was issued by the Director of Technology Center 3600 on July 13, 2005. In the Decision, the Director of Technology Center 3600 responded that the election restriction requirement was proper since multiple species exist, regardless of the existence of a generic claim. However, the Examiner alleges "Decision on Petition Regarding Restriction Requirement, mailed 7/13/2005, addressed and denied the Applicant's subject matter of the predetermined width of opening being generally less than the predetermined width of the base," in the Examiner's Communication mailed March 2, 2006.

Patentability of Claims 1-10

The patentability of Claim 11 was addressed in the Applicants' Response to Non-Final Office Action filed on June 21, 2005. Claims 1-10, which were withdrawn by the Examiner and are respectfully requested to be considered, are patentable over the prior art of record, and specifically over U.S. Patent No. 4,671,542 to Juchnowski for at least the reasons below.

"There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention." *Scripps Clinic & Research Foundation v. Genentech Inc.* 927 F.2d 1565, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991).

Juchnowski, nor any other prior art of record, does not teach or suggest "at least one groove includes an opening and a base each having a predetermined width, said predetermined width of said opening being generally less than said predetermined width of said base" as positively recited in independent claim 1.

Dependent claims 2-9, depending from independent claim 1, are also patentable by being dependent on an allowable base claim. Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection to independent claim 11, as addressed in the Applicants' Response to Non-Final Office Action filed on June 21, 2005, and allowance of claims 1-10, as addressed herein.

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Summary

Applicants provisionally elected Group I for continued examination on March 4, 2005 with traverse in response to an Election / Restriction Requirement dated February 14, 2005. While Applicants did not highlight the oversight by the Examiner in separating Figure 1, and Figure 4 (which is an enlarged view of a portion of Figure 1) into 'patentably distinct species,' Applicants continue to believe that a proper election was made of Group I, since any other choice presented by the Examiner. Furthermore, Applicants maintain that the Examiner has not acted on the timely filed Response to Non-Final Office Action of June 21, 2005. Applicants earnestly encourage the Examiner to consider the elected claims 1-11.

Conclusion

In view of the above, each of the presently pending claims in this application is in immediate condition for allowance. If, however, there are any outstanding issues that can be resolved by telephone conference, the Examiner is earnestly encouraged to telephone the undersigned representative. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicants believe no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. 60680-1814 from which the undersigned is authorized to draw. To the extent necessary, a petition for extension of time under 37 C.F.R. §1.136 is hereby made, the fee for which should also be charged to this Deposit Account.

Dated: March 17, 2006

Respectfully submitted,

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